

Notice of Allowability

Application No.

09/482,840

Examiner

Mark Fadok

Applicant(s)

PEINADO ET AL.

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment 7/28/2005 and amendment 11/2/2005.
2. ☒ The allowed claim(s) is/are 106-181.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 11/2/2005.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Claim 106. In combination with digital rights management (DRM) system operating on a computing device, the DRM system requiring a black box for performing decryption and encryption functions, a method of obtaining the black box by the DRM system from the black box server, the method comprising:

requesting, by the DRM system, a first black box from the black box server;

generating, by the black box server, the first black box, such generated first black box being unique and having a public/private key pair and electronic code for employing the key pair within the DRM system on the computing device;

delivering, by the black box server, the generated first black box to the DRM system; and

installing, by the DRM system, the delivered first black box in the DRM system;
and

the DRM system further providing code for periodically determining whether the black box is current and if not, upgrading the first black box from the black box server to a second black box.

DETAILED ACTION

Response to Amendment

The examiner is in receipt of applicants response to office action mailed 10/28/2004, which was received 7/28/2005. The examiner has carefully considered the amendments provided by the applicant and has found the 11/2/2005 amendment to be persuasive, therefore the following reasons for allowance are provided:

Rejoinder of Previously Withdrawn Claims

Independent claims 106,122,138,152, and 168 are directed to an allowable product. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims 107,108,111-118,123,124,126-134,141-148,153,154,157-164 and 171-178 directed to the process of making or using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, are now subject to being rejoined. Claims 107,108,111-118,123,124,126-134,141-148,153,154,157-164 and 171-178 are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Since all claims previously withdrawn from consideration under 37 CFR 1.142 have been rejoined, the restriction requirement made in the Office action mailed on 7/8/2005 is hereby withdrawn.

Allowable Subject Matter

Claims 1-181 are allowed.

The following is an examiner's statement of reasons for allowance of independent claims 106,122,138,152 and 168:

Regarding claims 106,122

The prior art of record neither anticipates nor fairly and reasonably teaches in combination with a digital rights management (DRM) system operating on a computing device, the DRM system requiring a black box for performing decryption and encryption functions, a method of obtaining the black box by the DRM system from a black box server, the method comprising, *inter alia*, the DRM system further providing code for periodically determining whether the first black box is current or not current, and upgrading at least the public/private key pair in the first black box server to result in a second black box when the first black box is not current.

Regarding claim 138

The prior art of record neither anticipates nor fairly and reasonably teaches in combination with a digital rights management (DRM) system operating on a computing device, the DRM system requiring a black box for performing decryption and encryption functions, a method of providing the black box by a black box server, the method comprising, *inter alia*, the DRM system further providing code for periodically

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determining whether the first black box is current or not current, and upgrading at least the public/private key pair in the first black box server to result in a second black box when the first black box is not current.

Regarding claims 152, 168

The prior art of record neither anticipates nor fairly and reasonably teaches a computer-readable medium having computer executable instructions thereon for performing a method in combination with a digital rights management (DRM) system operating on a computing device, the DRM system requiring a black box for performing decryption and encryption functions, the method for obtaining the black box by the DRM system and comprising, *inter alia*, the DRM system further providing code for periodically determining whether the first black box is current or not current, and upgrading at least the public/private key pair in the first black box server to result in a second black box when the first black box is not current.

Discussion of most relevant art:

US Patents and PG-PUB

(i) US Patent Downs et al (6,226,618), discloses method for electronic content delivery. Downs, however fails to anticipate or render the application's above-mentioned limitation(s) obvious.

(ii) US Patent 5,982,891 to Stefik et al, discloses a method controlling the delivery and use of digital content. Stefik et al, however, fails to anticipate or render the application's above-mentioned limitation(s) obvious.

(iii) US Patent 5,629,980 to Ginter et al, discloses a system and method for providing lead times on products ordered. Ginter et al, however, fails to anticipate or render the application's above-mentioned limitation(s) obvious.

Foreign Patent Documents

(iv) WO 99/13398 to Peterson et al. teaches a method for vending digital content, Peterson et al. however, fails to anticipate or render the application's above-mentioned limitation(s) obvious.

Non-Patent Literature

(v) Weber, R., "Digital Rights Management Technology" dated October 1995 teaches methods for developing rights protection. Weber, however, fails to anticipate or render the application's above-mentioned limitation(s) obvious.

Any comments considered necessary by the applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(571) 272-7159**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(571) 273-8300 [Official communications; including

After Final communications labeled

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"Box AF"]

(571) 273-6755 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a stylized, flowing script.

Mark Fadok

Primary Examiner